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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,405	07/08/2001	Imran Sharif	UNIQA-0030	6474

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EXAMINER
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JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/901,405

Applicant(s)

SHARIF ET AL.

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Action is in regards to the Reply received on 20 April 2005.

#### ***Response to Amendment***

1. This action is responsive to the application filed on April 20<sup>th</sup>, 2005. Claims 1-5, 7, and 11 were amended. No new claims are added. Claims 1-11 are pending. Claims 1-11 represent a "System and Method for Using an Internet Appliance to Send/Receive Digital Content Files as E-mail Attachments."

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3 and 5-11 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (i.e., a System and Method for Using an Internet Appliance to Send/Receive Digital Content Files as E-mail Attachments) to the claims which significantly affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

The references listed on the Information Disclosure Statement submitted on 02/03/03 have been considered by the examiner (see attached PTO-1449A).

Prior objection in the First Office Action in reference to claim 7 and rejection under USC § 112 second about claim 1, have been rescinded based on applicant correction submitted on 04/20/2005.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, and 5-11 are rejected under 35 U.S.C. 102(e) as being unpatentable by Dawson (U.S. 6,252,588 B1).

**Regarding claim 1:** Dawson teaches a system for exchanging digital content files as email attachments (*column 8, lines 1-8*), comprising:

a system server connected to a communications network and implementing a standard electronic mail protocol for sending and receiving email and digital content email attachments via the communications network (*column 22, lines 13-16; column 20, lines 38-50; fig. 14, items 1431-1435*);

the system server having storage and retrieval means for a plurality of user interface display screens and digital content files (*column 22, lines 62-64*);

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an Internet appliance for receiving a reduced keyset keystroke sequence, a connection with the communications network for establishing a client relationship with the system server (*column 22, lines 62-64*), a browser for accessing user interface display screens via the network connection (*column 1, lines 35-53*), a video/audio converter providing output signals compatible with a standard television receiver for display of accessed user interface display screens (*column 8, lines 51-52*), and hyperlink selection means responsive to the received keystroke sequence for navigating an accessed user interface display screen (*column 12, lines 1-8; column 5, lines 51-52*);

the user interface screens and the reduced keyset keystroke sequence defining a text entry and editing protocol, an email creation and addressing protocol, an email viewing protocol, and an email deletion protocol (*column 28, lines 36-57; fig. 18, item 1809*);

the user interface screens and the reduced keyset keystroke sequence also defining an email attachment selection protocol permitting selection of digital content files for attachment to a user created email (*fig. 2, items 200, 216, 218*);

the system server including means responsive to the email attachment selection protocol and the reduced keyset keystroke sequence for retrieving a selected digital content file, and for encoding the retrieved file as a standard email attachment (*fig. 4, items 415-423*);

the system server including means for establishing a connection via the communications network with a standard email server, and for sending the email and

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encoded attachment to the email server using the standard email protocols (*column 22, lines 13-16; fig. 14, items 1431-1435*);

the system server including means for establishing a connection via the communications network with the email server for receiving email and encoded attachments, for decoding the attachments, for storing the received email and decoded attachment, and for notifying the Internet appliance that an email and attachment has been received (*column 17, lines 22-67; column 18, lines 1-35*).

**Regarding claim 2:** Dawson teaches the system of claim 1, further including hand-held reduced keyset means for creating and transmitting the reduced keyset keystroke sequence (*column 30, lines 46-54*).

**Regarding claim 3:** Dawson teaches the system of claim 2, wherein the hand-held reduced keyset means defines a remote control unit that transmits the reduced keyset keystroke sequence as an infra-red beam, and wherein the Internet appliance is adapted for receiving the infra-red beam (*column 30, lines 46-54*).

**Regarding claim 5:** Dawson teaches the system of claim 1, further including a standard television receiver connected to receive the converted video/audio output signals for display of user interface display screens, and embedded hyperlinks, including system email protocol display screens, received emails, entered text, screens permitting text editing, digital content file selection, and email recipient address selection and entering (*column 8, lines 34-50*).

**Regarding claim 6:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and keystroke parsing engine for

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converting a reduced keyset keystroke sequence to text and displaying the text as the body of a new email (*column 1, lines 39-53*).

**Regarding claim 7:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and keystroke parsing engine for interpreting a reduced keyset keystroke sequence as editing commands for entered text within the body of the new email and for displaying an editing process (*column 2, lines 18-26; fig. 3 items 309-311*).

**Regarding claim 8:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to access a display of available digital content files, and selecting a digital content file for attachment to a new email (*column 2, lines 18-49; fig. 2, items 216-218; fig. 3, item 304*).

**Regarding claim 9:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to display available email recipient addresses to edit a displayed address, and to enter a new email recipient address (*column 2, lines 31-35*).

**Regarding claim 10:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to select a display of a list of received emails and email attachments (*fig. 2, items 201, 217*).

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**Regarding claim 11:** Dawson teaches the system of claim 1, wherein the defined email protocols include a user interface display screen and parsing engine permitting a reduced keyset keystroke sequence to select and view a received email, and to select and view/listen to email attachments (*column 8, lines 9-15*).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (U.S. 6,252,588 B1) in view of Chang et al (U.S. 6,598,076 B1).

**Regarding claim 4:** Dawson teaches all the limitations of the system of claim 2, but fail to disclose a system wherein the hand-held reduced keyset means defines a wireless telephone, and wherein the Internet appliance is adapted for receiving the reduced keyset keystroke sequence from the wireless telephone.

However, Chang et al (*column 3, lines 15-18*) teach a network system wherein, "*devices such as wireless device in the nature of a wireless telephone or a wireless pager or a wireless PDA can be connected*".

It would have been obvious for an ordinary skill in the art at the time of the invention to use the wireless telephone of Chang et al for the hand-held reduced keyset



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remote control of Dawson *"to send and receive an electronic message"* as stated by Chang et al in lines 20 and 21 of column 3.

Chang et al teach that it is old and well known in the network communications art to get the advantage using a wireless telephone to send keystroke sequences to an Internet appliance. An artisan in the network communications art at the time of the invention would have been motivated to include this device to get the advantage of receiving reduced keystroke sequences in an electronic network.

### ***Response to Arguments***

7. Applicant's Request for Reconsideration filed on April 20<sup>th</sup>, 2005 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. In reference to the rejection of claims 1-3, and 5-11, applicants contend the Dawson patent fails to disclose or suggest, and is not all related to, the distributed system approach described in **claim 1**.

B. Applicant contends that Claim 4 is not obvious for the same reason stated in Point A.

8. As to "Point A" it is the position of the Examiner that Dawson in detail teaches the limitations of the above mentioned claims. However, in view of Applicant's remarks, stating that Dawson does not teach a distributed system, it is important to note that applicant never specifically claim a "distributed system". Furthermore, Dawson

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teaches an e-mail distributed system and shows the connections between each functional section and shows of how the functional components combine to form an implementation of the visual e-mail network system (see Dawson, fig. 18; column 30, lines 28-67). Applicant's arguments are deemed moot in view of the grounds of rejection specified in the First Office Action [*see rejection above*].

As to "Point B", it is also the Examiner's position that the reason used to maintain the rejection of 1-3, and 5-11 as explained in point A above, is also valid for to maintain the rejection of claim 4, as claim 4 depends on claim 1.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

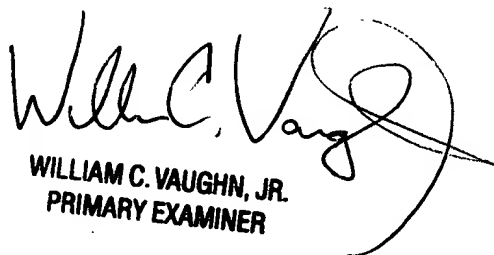
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

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WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER

JJG



July 7, 2005